

REMARKS

The non-final Office Action mailed September 21, 2004 has been reviewed and carefully considered. Claims 1-35 are pending in the application. Claims 1, 3-10, 12-19, 21-27 and 29-35 were rejected. Claims 2, 11, 20 and 28 were objected to.

Applicants appreciate Examiner's indication of allowability of claims 2, 11, 20 and 28.

In paragraph 3 on page 2 of the Office Action, claims 1, 3-10, 12-19, 21-26 and 35 were objected to under 35 U.S.C. § 102(e) over Egan et al. (U.S. Patent No. 6,452,735).

In paragraph 5 on page 4 of the Office Action, claims 27 and 29-34 were rejected under 35 U.S.C. § 103(a) over Egan in view of Gong et al. (U.S. Patent No. 6,683,737).

Applicants respectfully traverse the §§ 102(e) and 103(a) rejections. Applicants respectfully assert that the requirements for either a § 102(e) or a §103(a) rejection are not present and a *prima facie* rejection fails because the Office Action fails to cite a reference or references that teach, disclose or suggest all the claim limitations of Applicants' application.

Applicants' application discloses a controller that requires at least "a processor for controlling a write operation and for receiving a thermal signal from a read channel, wherein the processor compares the thermal signal to a predetermined threshold to determine whether to initiate a re-write operation."

Egan, at column 5, lines 16-23 teaches "a threshold detector 108 for receiving the thermally induced signal and generating a digital high fly write detection signal at line 110 when the magnitude of the thermally induced signal exceeds a threshold value, and a disk controller 112 for modifying the write operation in response to the high fly write detection signal." Because the threshold detector 108 receives and compares the thermally induced signal to a predetermined threshold, and the disk controller modifies write operations, Egan fails to disclose, teach or suggest "a processor for controlling a write operation *and* for receiving a thermal signal from a read channel, wherein the processor compares the thermal signal to a predetermined threshold to determine whether to initiate a re-write operation." (emphasis added)

Similarly, and moreover, Egan, at column 7, lines 44-48 teaches that "Once the threshold detector 108 determines that the magnitude of the thermally induced signal exceeds the threshold value and asserts the high fly write detection signal, the disk controller 112, which is a

microprocessor, performs the necessary modifications to the write operation.” Because threshold detector 108 merely determines whether the thermally induced signal exceeds a threshold and sends a signal to the disk controller, and the disk controller performs write operations, Egan fails to disclose, teach or suggest “a processor for controlling a write operation *and* for receiving a thermal signal from a read channel, wherein the processor compares the thermal signal to a predetermined threshold to determine whether to initiate a re-write operation.”

Dependent claims 2-9, 11-18, 20-26, and 28-34 are also patentable over the references, because they incorporate all of the limitations of the corresponding independent claim 1, 10, 19 and 27. Further, dependent claims 2-9, 11-18, 20-26, and 28-34 recite additional novel elements and limitations. Applicants reserve the right to argue independently the patentability of these additional novel aspects. Therefore, Applicants respectfully submit that dependent claims 2-9, 11-18, 20-26, and 28-34 are patentable over the cited references.

With respect to the § 103(a) rejections of the claims, the alleged motivations for making the asserted combinations are improper for being conclusory and lacking supporting evidence. According to MPEP § 2143.01, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” The § 103(a) rejection of the claims is not given supporting evidence. The alleged motivation for making the Egan-Gong combination is “motivation being ease of providing the computer with the instructions to perform the method steps.” The motivation is improper because no evidence is provided in the references to indicate the asserted combinations would be desirable. Therefore, the alleged motivations are improper.

Without complete correspondence to the claimed invention, the Section 102 rejection cannot stand and Applicants request that the rejections be withdrawn. Therefore, Applicants respectfully submit that claims 1, 3-10, 12-19, 21-26 and 35 are patentable over Egan. Because the combination of Egan with Gong, fails to teach, disclose or suggest all the elements of at least the first claim, the Section 103(a) rejections are improper and should be withdrawn.

On the basis of the above amendments and remarks, it is respectfully submitted that the claims are in immediate condition for allowance. Accordingly, reconsideration of this

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application and its allowance are requested. Please charge/credit Deposit Account No. 50-0996 (HITG.106US01) for any deficiencies/overpayments.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Attorney for Applicants, David W. Lynch, at 651-686-6633 Ext. 116.

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